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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/897,344

07/03/2001

John T. Giles

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8262

24314

7590

01/14/2004

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EXAMINER

POKER, JENNIFER A

ART UNIT

PAPER NUMBER

2832

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/897,344

Applicant(s)

GILES ET AL.

Examiner

Jennifer A. Poker

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2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 10-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection (advisory action). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 7, 2003 has been entered.

### *General Status*

2. This is a third action on the merits of application filed on July 3, 2001. Claims 1-18 are pending. Claims 1-9, 17, and 18 are being examined, while claims 10-16 have been withdrawn.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9, 17, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(a) Applicant claims in claim 1 that the skirt portion is mechanically attached to the rigid face portion through a mating connection. This limitation is not found within the specification.

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(b) Applicant claims in claim 2 that a male interconnecting member and a female interconnecting member accomplish the mating connection. This limitation is not found within the specification.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent Number 5,612,692 to Dugas, et al.

Dugas, et al, discloses a fully backlighted keyboard the keys comprising:

- (1) An upper surface having light transparent regions, (Abstract);
- (2) An opaque skirt and sidewalls, wherein the sidewalls may be transparent, opaque, or translucent; the skirt and sidewalls being attached to the upper surface, (Abstract);
- (3) A cavity found within the center of each key. (Column 2, lines 32-33);

Dugas, et al, states that most of the components may be molded from plastic, although other suitable materials may be employed. (Column 10, lines 55-56).

Dugas, et al, discloses the claimed invention except for the mechanical attachment of the face and skirt portions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize two portions and form them together, since it has been held that

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constructing a formerly integral structure in various elements involves only routine skill in the art.

*Nerwin v. Erlichman*, 168 USPQ 177, 179.

7. Claims 2-9, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,612,692 to Dugas, et al, in view of U.S. Patent Number 5,588,760 to So.

Regarding claims 2, Dugas, et al, discloses the claimed invention except for the male and female mating connection. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to utilize male and female connection members since it was known in the art that male and female connection members are a common method of mating two components. An example reference is illustrated below.

So discloses a key switch for a computer keyboard wherein a key holder is used for mounting key switches. Each of the key holders comprises at least one female guide means for engagement with the male guide means one key switch. (Figure 3; column 3, lines 38-40)

One skilled in the art, at the time the invention was made, would have found it obvious to combine the teachings of Dugas, et al, with the teachings of So, and utilize a female/male mating connection in order to form a secure connection between the two components of the key/switch.

Regarding claims 3-7 and 18, Dugas, et al, further discloses:

(1) An LED is disposed on a printed circuit board beneath the keyboard for illumination. (Abstract);

(2) Indicia on the upper surface, which are illuminated by light from the LEDs, which passes through the translucent dome and is visible through the transparent upper surface. (Column 2, lines 36-39);

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(3) A pair of opposed fingers with projections attached to the upper surface and extending downward to make contact with the switch. (Figure 4A);

Dugas, et al, states that most of the components may be molded from plastic, although other suitable materials may be employed. (Column 10, lines 55-56).

Regarding claims 8, 9, and 17, Dugas, et al, in view of So, discloses the claimed invention except for the negative image and sublimation process.

Regarding claims 8 and 17, due to applicant's own admission (disclosure, page 8, line 14-16), "The preferred printing process is a heat transfer/sublimation process utilizing dye-bearing sheets in mirror-negative image of the preselected images. Such processes are well known in the industry." Applicant admits that one with ordinary skill in the art would have known that such process existed for utilization for the formation of the indicia onto the key cap in order to provide an image for an operator to see what key it is that he/she may be using.

Regarding claim 9, even though the claim is limited by and defined by the recited process (sublimation process as claimed), the determination of patentability of the product is based on the product itself, and does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). Furthermore, it is well settled that the presence of process limitations (sublimation process as claimed) in product claims, which product does not otherwise distinguish over the prior art, cannot impart patentability to that product. (*In re Johnson*, 157 USPQ 670 1968)

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*Response to Arguments*

8. Applicant's arguments with respect to claims 1-9, 17, and 18 have been considered but are moot in view of the new ground(s) of rejection.

*Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Poker whose telephone number is 703-305-4037. The examiner can normally be reached on 5:30-4:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin G. Enad can be reached on 703-308-7619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

jap  
January 7, 2004

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JENNIFER A. POKER  
PRIMARY EXAMINER  
GROUP 2109